

Docket No. F-8958

Ser. No. 10/573,214

REMARKS

Claims 1 and 3-20 are now pending in this application. Claims 1-20 are rejected. Claims 1, 3 and 4 are amended herein. Claim 1 is merely amended to incorporate the subject matter of now cancelled claim 2, while claims 3 and 4 are amended to depend from claim 1 instead of cancelled claim 2. Thus, the amendments do not raise new issues since the subject matter claim 1 is now the same as former claim 2. Accordingly, entry of the present Amendment after Final Rejection is respectfully requested.

SECOND REQUEST FOR ACKNOWLEDGMENT OF PRIORITY DOCUMENTS

The Examiner in the present Office Action acknowledges receipt of the PCT International in the body of the Office Action. This is not what has been requested. The present application is a national stage application of a PCT application, the priority document was filed with the International Bureau, and again applicant respectfully requests acknowledgment of the priority document which is JP 2003-339086 as cited in the ADS filed with the application. This acknowledgment should be made in line 12 of the Office Action Summary.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, DESCRIPTION REQUIREMENT

Docket No. F-8958

Ser. No. 10/573,214

Claims 1-20 are rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter lacking an adequate written description in the specification. The Office Action states the following:

the newly introduced limitations of "opposing outer absorbent body edges", "a middle-height portion layered oversaid standard height portion", side edge steps", and "side walls of the leakage preventing grooves equal on opposing sides of said leakage preventing grooves" are not supported by the Applicant's specification.

Office Action, pgs 3-4. Applicant herein respectfully traverses this rejection.

The description requirement of the first paragraph of 35 U.S.C. § 112 functions to ensure that the inventor had possession of the subject matter later claimed. How the specification satisfies this requirement is immaterial. It is not necessary that the application describe every claim exactly, but only so much that persons of ordinary skill in the art will recognize from the disclosure that the applicant invented the subject matter with the claimed limitations. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 96 (CCPA 1976). In other words, the claimed subject matter need not be described in *haec verba* in the specification in order for the specification to satisfy the description requirement. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). Therefore, a determination of fulfillment of the description requirement under § 112, first paragraph, turns on whether those skilled in the art would understand what is claimed when the claim is read in light

Docket No. F-8958

Ser. No. 10/573,214

of the specification. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

Applicants find the rejection under the description requirement to be rather puzzling as each item listed in the rejection is clearly shown in the drawings. Also, several of the items noted are specifically discussed in the specification. For instance, the "a middle-height portion layered over said standard height portion" is shown in Fig. 1A wherein the middle height portion 6 is shown as a layer over the standard height portion 6 and described in the paragraph bridging pages 8 and 9 of the originally filed specification. Furthermore, while not required by the claim language, the middle height portion may be embodied by lamination, which is clearly stated on page 9, lines 1-6, however the middle height may also be formed as related on page 9, lines 20-24.

The claimed "opposing outer absorbent body edges" are clearly supported by Figs. 1 and 5 wherein the absorbent body 4 is shown having edges which run in the vertical direction of the figures. Likewise, "side edge steps" are shown by Figs. 2 and 6 wherein the middle-height portion 6 has edges on right and left sides of the figures which form steps, hence "opposing middle-height portion side edge steps" are shown. Finally, the claimed and argued "side walls of the leakage preventing grooves equal on opposing sides of said leakage preventing grooves" are likewise clearly shown as the walls that form groove 8 in Figs. 2, 3 and 6. Additionally, the specification acknowledges that deep walls serve better to retain fluids, which is why

Docket No. F-8958

Ser. No. 10/573,214

the grooves are placed in the middle height portion which allows deeper walls on both sides in contrast to a rounded structure of the prior art. Page 10, lines 4-11, Hence, putting grooves in a position wherein the walls are of unequal height as is done in the prior art reduces the effectiveness of retain fluids and stopping seepage to that possessed by the wall of lesser height, yet at the expense of having a wall of greater height resulting in a bulkier product for the degree of liquid retention provided than if the walls were of equal height. Furthermore, it is submitted that the drawings are sufficient support in and of themselves for the claimed groove walls because one skilled in the art would certainly understand that the grooves in the flat middle height portion have equal height side walls.

The Examiner is reminded that it is well settled that the applicant may be his own lexicographer, defining his own terms in the specifications and claims, and that the claims must be interpreted in light of the specification. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (CAFC 1985). Furthermore as noted above, there need not be word for word correspondence between claim terminology and the specification for the description requirement to be satisfied. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). The specification need only describe the invention in a manner sufficient that those skilled in the art would understand what is claimed. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). In view of the proper descriptiveness standard, it is respectfully submitted that the specification, including the drawings read in

Docket No. F-8958

Ser. No. 10/573,214

conjunction with detailed description, far more than adequately apprizes one skilled in the art that the inventor possessed the claimed invention at the time of filing. Therefore, in view of the above, reconsideration of the objection to specification and rejections of claims 1-20 are respectfully requested. Should such objection and rejections be maintained, it is requested that the Examiner explain the grounds for the objection and rejections, addressing the above remarks, to comply with satisfying the burden of the PTO in asserting the rejection. "The burden of showing that the claimed invention is *not* described in the application rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient." *In re Edwards, Rice, and Soulen*, 196 U.S.P.Q. 465, 469 (CCPA 1978) *citing: In re Salem*, 553 F.2d 676, 682, 193 USPQ 513, 518 (CCPA 1977); *In re Wertheim*, 541 F.2d at 265, 191 USPQ at 98.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-20 are rejected as obvious over Shimoe reference in view of the JP 2003230593 ('593) reference under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

Applicant initially addresses the Examiner's remarks in the Response to Arguments. In the response the Examiner alleges the claims do not require a

Docket No. F-8958

Ser. No. 10/573,214

“distinct middle height portion.” This statement is incorrect. Claim 1 recites “said absorbent body having a standard-height portion and a middle-height portion layered over said standard height portion” hence specifically requires the noted “middle height portion.” The claim further requires “said middle-height portion having opposing middle-height portion side edge steps and a constant middle-height portion thickness extending from one of said opposing middle-height portion side edge steps to another one” which further distinctly defines the “middle height portion” based on thickness and defining edges. Hence, it is respectfully submitted that the “middle height portion” is distinctly claimed in the claim language and hence “distinct.” The is respectfully requested that the Examiner properly interpret the claim language.

Still further, the Examiner makes a specious argument akin to trying to fit a round peg in a square hole. The Examiner suggests that a round shape teaches a stepped configuration based upon abstract geometric principles. The Examiner is reminded that the prior art is to be interpreted as a whole and in the manner of one skilled in the art, in this case the art is paper product design, especially sanitary napkins, and not a geometry teacher. While the remarks are creative they do not provide a acceptable basis for finding a stepped configuration in a round structure, as is apparently recognized by the Examiner now turning to the 593 reference for teaching a middle height portion layered over a standard height portion, and grooves having walls of equal height.

Docket No. F-8958

Ser. No. 10/573,214

It well accepted that in order to properly determine obviousness, the analysis “ must start with the claimed invention as a whole. . . . [especially where the invention is comprised] of old elements so arranged as to perform certain related functions.” *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 USPQ 603, 609-10 (Fed. Cir. 1984) In the *Kimberly*, the court stated:

It is immaterial to the issue, however, that all of the elements were old in other contexts. What must be found obvious to defeat the patent is the claimed combination.

Id. It is respectfully submitted that the analysis supporting the present rejection fails to consider the claimed invention as a whole, i.e., the combined interaction of each claimed element of the invention.

The Shimoe reference lacked teaching a distinct middle height portion and standard height portion but instead provided a doomed configuration with grooves in the middle portion. Claim 1 was amended to recite the following feature not found in the Shimoe reference:

said middle-height portion having opposing middle-height portion side edge steps and a constant middle-height portion thickness extending from one of said opposing middle-height portion side edge steps to another one of said opposing middle-height portion side edge steps[.]

Furthermore, the presently claimed invention includes:

said leakage preventing grooves being provided in the area of the middle-height portion of the absorbent body with opposing side walls of said grooves being formed in said middle-height portion such that depths of said opposing side walls of said leakage preventing

Docket No. F-8958

Ser. No. 10/573,214

grooves are equal on opposing sides of said leakage preventing grooves[.]

In addition to the above features, one reading the claim in a manner to appreciate in the invention as whole will realize that the claim also requires:

leakage preventing grooves, extending in said longitudinal direction of the absorbent article which is orthogonal to a lateral direction extending between said opposing outer absorbent body[.]

The feature of the grooves extending in the longitudinal direction and having opposing side walls of equal depth formed by the constant middle-height portion provides functionality not rendered obvious by the combination of applied references.

Still further claim 1 incorporates claim 2 to recite:

the leakage preventing grooves being deeper than said constant middle-height portion thickness and extending into the standard-height portion of the absorbent body.

In the Response to Arguments section the Examiner states with regard to applicant pointing out the feature of the equal height side walls:

However, the level of leakage prevention straightly depends of the groove liquid capacity, wherein the liquid capacity of the groove can never be defined by the fact of equality of the groove side walls, but by the depth of the smaller wall only. Since the smaller wall of Shimoe's grooves is fully capable of providing the desired level of the groove liquid capacity, the grooves with the walls of equal depth is the matter of an obvious design choice, and as such it does not impact the patentability of the claim. Nevertheless, the second reference JP 2003230593 has been brought in support to the obviousness rejection (See the Rejection below).

Docket No. F-8958

Ser. No. 10/573,214

This statement clearly evidences that the claimed invention *as a whole* is not being considered. The Examiner has dismissed the feature of equal height longitudinal groove walls in the middle height portion as a mere "design choice." However, the Court of Appeals of the Federal Circuit has stated that the finding of "obvious design choice" is precluded where the claimed structure and the function it performs or functioning thereof are different from the prior art. *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995); See *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992). Furthermore, applicant need not detail such differences in the specification since it is not for the applicant "to divine the rejections the PTO will proffer when patent applications are filed. *In re Chu*. Accordingly, applicant sets forth below the functional differences of the noted feature.

The claimed invention places longitudinally running grooves wholly in the middle-height portion to provide walls of equal height on both sides thus providing improved liquid retention for the bulk existing because the constant height middle-height portion requires equal height walls. The Shimoe reference put grooves into a curved domed configuration, the outer side wall of the grooves being shorter than the inner side wall. Thus, the amount of fluid buildup in the Shimoe groove prior to leakage is less for the given thickness of the Shimoe article than an article of the present invention because an amount of extra height of the higher wall in the Shimoe reference does not contribute to liquid retention yet still contributes to bulk. Thus,

Docket No. F-8958

Ser. No. 10/573,214

the claimed configuration of the invention provides a functional difference not found in the applied reference and *cannot* be dismissed as an obvious design choice. It is requested that the Examiner carefully review the specification, in particular at pages 9 and 10 wherein it is noted that deeper longitudinal grooves are provided in the middle-height portion.

In setting forth the obviousness rejection the Examiners relates the Shimoe reference as showing:

the leakage preventing grooves 19 (Fig. 2) are deeper than a thickness of the middle-height portion and reach the standard portion absorbent body (See Fig. 2)[.]

However, since the Shimoe reference does not disclose a distinct middle-height portion and a standard height portion as claimed, it surely cannot disclose that grooves extend into a standard-height portion of the absorbent body because there is no defined standard-height portion. Thus, it is respectfully submitted that the obviousness rejection is defective in this regard.

The Examiner then turns to the '593 reference and asserts that it teaches "the leakage preventing grooves comprise side walls equal in height." It is respectfully submitted that this rejection is defective because the groove 9F relied in the '593 reference on does not extend along a longitudinal edge of the middle height portion, and does not even extend in the longitudinal direction. Fig. 10 is a cross section

Docket No. F-8958

Ser. No. 10/573,214

taken in the longitudinal direction therefore the groove 9F runs in the lateral direction.

Instead, the '593 reference has longitudinal leakage preventing grooves 8 that have unequal side walls and are formed at the stepped edge of the middle height portion. The grooves (grooves 8) in the '593 reference are grooves formed to the outside of the middle height portion, and correspond to the leakage preventing grooves used in the conventional absorbent article, which is shown in FIG. 8 of the present specification, and thus are clearly different from those of the present invention. The grooves are not in a middle height portion so disposed as to have the same height on both sides, in the manner of the present invention.

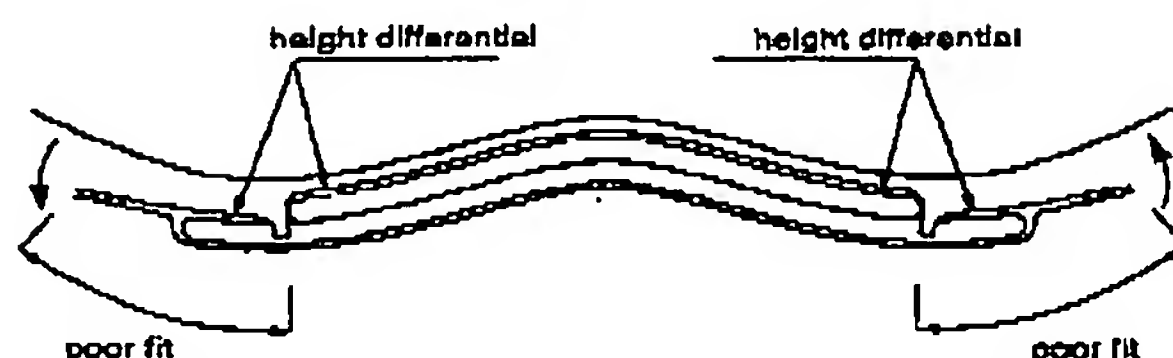
In the present invention, the height is the same to the outside of the leakage preventing grooves and to the inside thereof, so that the skin is contacted on both sides of the grooves and leakage of liquid can be prevented. In the "593 reference" the grooves (grooves 8) have a structure wherein the height to the outside of the groove is low, and thus the skin is not contacted. If the leakage preventing groove is formed to the outside of the middle height portion, as in the '593 reference, as shown in the accompanying reference FIG. A (sectional view showing the situation in which

Docket No. F-8958

Ser. No. 10/573,214

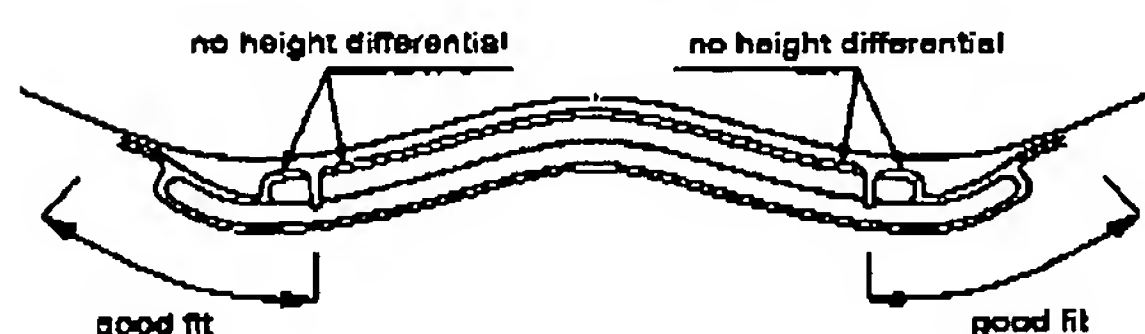
Reference FIG. A

(leakage preventing grooves formed to the outside of the middle-height portion)



Reference FIG. B

(leakage preventing grooves formed within the middle-height area)



a napkin is worn), the middle height portion contacts the human body, but due to the height difference in the absorbent body, the portion of the absorbent body that is to the outside of the leakage preventing groove tends to separate from the human body, and readily folds to the exterior at the leakage preventing groove. Consequently, if liquid flows out sideways and reaches the leakage preventing groove, after flowing into the leakage preventing groove, this liquid tends to overflow from the leakage

Docket No. F-8958

Ser. No. 10/573,214

preventing groove, meaning that this does not function as a leakage preventing groove.

Conversely, with the present invention in which the leakage preventing grooves are formed in the middle height area, as shown in Reference FIG. B, the height of the absorbent body to the outside of the leakage preventing groove is the same as the height of the absorbent body to the inside of the leakage preventing groove, and thus liquid that flows into the leakage preventing groove can be retained without overflowing. Furthermore, as formerly recited in claim 2, and now included in claim 1, because the leakage preventing groove is deep, large amounts of liquid can be absorbed and retained within the leakage preventing groove. Thus, as described above, the leakage preventing groove according to the present invention and the leakage preventing groove disclosed in the '593 reference are different in both structure and effect.

Applicants *again note for the second time* that the Examiner rejects claim 4 based upon an improper reading of the Shimoe reference. The folding lines of claim 4 are not shown by the Shimoe reference. The Examiner has misinterpreted the drawings of the Shimoe reference as showing folding lines. Instead, the line referred to by the Examiner is merely a mechanical drawing indication of an extent of width as made readily apparent by the arrows and the notation "W." This line has no bearing on the structural configuration of the Shimoe reference except to indicate the minimum distance between the grooves. Hence, it is respectfully

Docket No. F-8958

Ser. No. 10/573,214

requested that the Examiner *carefully review* the representations set forth in the drawings before concluding that structural elements are shown.

In view of the above, it is respectfully submitted that claims 1 and 3-20 particularly describe and distinctly claim a combination of elements not rendered obvious by the applied references. Therefore, reconsideration of the rejections of claims 1-20 and their allowance are respectfully requested.

REQUEST FOR EXTENSION OF TIME

Applicants respectfully request a one month extension of time for responding to the Office Action. The fee of \$130 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Docket No. F-8958

Ser. No. 10/573,214

In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By *C. Bruce Hamburg*
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Gy and,

By *H. F. Ruschmann*
Herbert F. Ruschmann
Reg. No. 35,341
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Form PTO-2038.